

REMARKS/ARGUMENTS

Claims 1, 2, 4-13, 15-16 and 18-28 are pending in the application. Claims 3, 14 and 17 have been cancelled without prejudice.

Status of Related Applications

The following U.S., foreign, and international patent applications are or may be considered to be related to the application herein. Relevant documents pertaining to such cases are or have been provided in one or more separately-filed Information Disclosure Statements. The status of such applications is summarized in order to ensure that the Office is fully apprised of the current state thereof. In the event the Office has any questions about the identified cases, the Examiner is requested to call the Applicant's representative at the number below.

Serial No.	Country	Status
2,458,098	Canada	Pending

Claim Rejections – 35 USC § 103

Claims 1, 2, 4-13, 15, 16 and 18-26 stand rejected having regard to of U.S. Patent No. 6,049,796 to Siitonen et al. ("Siitonen") in view of U.S. Patent No. 6,950,988 to Hawkins et al. ("Hawkins"), in view of U.S. Publication No. 2004/0155908 to Wagner ("Wagner"), in view of U.S. Patent No. 7,295,852 to Davis et al. ("Davis"), and further in view of U.S. Patent No. 7,072,461 to Padawer et al. ("Padawer").

For the purposes of this response, claim 1 is representative. Claim 1 recites:

"at least one component to compose a destination for an outgoing communication generated by a respective one of the at least two communication capabilities of the device"

"wherein the at least one component to compose a destination for a respective one of the at least two communication capabilities is invocable from the main screen via selection of the application icon for the respective communication capability and is

also invocable in response to an alphanumeric input from the first input device of a portion of the destination, the component to compose a destination being invoked depending on the type of alphanumeric input.”

Thus, claim 1 describes a main screen from which different communication capabilities may be invoked. In particular, different composition components for respective different communication capabilities can be invoked from the main screen using two different methods: i) by selecting the icon for the respective communication capability; or ii) by inputting an alphanumeric character. The claims describe where both options for invoking the composition component are simultaneously available from the main screen.

Claim 1 also describes where the specific composition component that is invoked is dependent on the type of alphanumeric input. For example, input of a portion of a telephone number (e.g., a numeric input) may invoke a composition component for a telephone communication capability, while input of a portion of an email address (e.g., an alphabetic input) may invoke a different composition component for an email communication capability.

Legal requirements for a finding of obviousness

In order to reject a claim based on a combination of references, as explained at MPEP 2143 (citing the Supreme Court in *KSR v. Teleflex*), “Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

KSR, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

In the present case, the Applicant submits that the elements of claim 1 are not all found in the cited references.

The cited references do not teach "wherein the at least one component to compose a destination for a respective one of the at least two communication capabilities is invokable from the main screen via selection of the application icon for the respective communication capability and is also invokable in response to an alphanumeric input"

The Office Action, on page 5, concedes that Siitonen, Hawkins and Wagner do not disclose that the component to compose a destination for a respective communication capability is invokable from the main screen via selection of the application icon for the respective communication capability. Davis is relied upon to remedy these deficiencies.

Notably, claim 1 does not only recite that the component to compose a destination is invokable via selection of an application icon, but that the component to compose a destination is also invokable in response to an alphanumeric input at the main screen. Thus, what is being claimed is not simply that invoking a component to compose a destination is possible by selecting an application icon on a main screen, but that additionally the component to compose a destination can be invoked by entering alphanumeric input. The present claims provide two ways to invoke a component to compose a destination - selection of an application icon or directly entering alphanumeric input.

None of Siitonen, Hawkins, Wagner and Davis teaches or suggests providing these two alternatives at the same time on the main screen, for invoking a component to compose a destination. In fact, on page 6, the Office Action concedes that none of Siitonen, Hawkins,

Wagner and Davis teaches or suggests any alphanumeric input and invoking a component to compose a destination depending on the type of alphanumeric input.

Therefore, the claimed feature “wherein the at least one component to compose a destination for a respective one of the at least two communication capabilities is invokable from the main screen via selection of the application icon for the respective communication capability and is also invokable in response to an alphanumeric input” is not taught or suggested by the cited references.

The cited references do not teach “the component to compose a destination being invoked depending on the type of alphanumeric input”

The Office Action concedes, on page 6, that Siitonen, Hawkins, Wagner and Davis do not disclose an alphanumeric input and component to compose a destination being invoked depending on the type of the alphanumeric input. Padawer is relied upon to remedy these deficiencies.

Claim 1 recites: “at least one component to compose a destination for an outgoing communication generated by a respective one of the at least two communication capabilities...the component to compose a destination being invoked depending on the type of alphanumeric input.” That is, there are different components for composing a destination for respective different communication capabilities. When there is alphanumeric input, which one component to compose a destination is invoked depends on the type of alphanumeric input. For example, numeric input might invoke a component to compose a destination for telephone communication (e.g., dialling a telephone number) while alphabetic input might invoke a component to compose a destination for email communication (e.g., entering an email address).

In contrast, Padawer is concerned only with dialling a number on a telephone device. Padawer teaches that different dialling methods can be used for dialling a number for a telephone call, and the appropriate database (e.g., contacts database, speed dial database or call log database) will be queried, based on the user input, to provide the dialling number.

In Padawer, there is only one communication capability - telephony. As shown in figures 2A-2F of Padawer, there is only one component to compose a destination that is provided and it is only for voice communications, namely telephony. What is taught by Padawer is that different input methods may be used to dial a number using a single component to compose a destination.

In contrast, claim 1 recites different components to compose a destination for each respective one of the two or more communication capabilities. In claim 1, different components to compose a destination are invoked, depending on the type of alphanumeric input. This is entirely different from the focus of Padawer, which aims to use a single component to compose a destination, even if different types of input are used.

Thus, Padawer does not teach or suggest the claimed elements: “at least one component to compose a destination for an outgoing communication generated by a respective one of the at least two communication capabilities...the component to compose a destination being invoked depending on the type of alphanumeric input.”

Therefore, Padawer fails to remedy the admitted deficiencies of Siitonen, Hawkins, Wagner and Davis.

Summary

In view of the foregoing, Siitonen, Hawkins, Wagner, Davis and Padawer, whether taken alone or in combination, fail to teach or suggest at least the claimed features:

“wherein the at least one component to compose a destination for a respective one of the at least two communication capabilities is invokable from the main screen via selection of the application icon for the respective communication capability and is also invokable in response to an alphanumeric input” and

“the component to compose a destination being invoked depending on the type of alphanumeric input.”

Therefore, the Applicant submits that the present claims are all patentable over the cited references.

Improper hindsight analysis applied

In addition to the reasons provided above, the Applicant further requests that the rejection under 35 U.S.C. 103(a) be withdrawn on the basis that the rejection is based on the use of improper hindsight analysis.

The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil* (1985), the Federal Circuit noted that "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." In *In re Fritch* (1992), the Federal Circuit noted:

"[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In the present case, in this eighth Office Action, no less than five separate references are relied upon to arrive at the present claims. Each of the cited references is deficient in teaching the elements of the present claims in some way. Each of the cited references teaches a different way of composing a communication destination or invoking an application. Considering that each reference provides a different solution, there is no reason for a person skilled in the art to continue searching and combining references in the manner suggested in the Office Action, unless motivated by improper hindsight analysis based on the teachings and claims of the present application.

Therefore, the Applicant submits that the combination of Siitonen, Hawkins, Wagner, Davis and Padawer is based on improper hindsight analysis and is improper for a rejection under 35 U.S.C. 103(a). The Applicant respectfully asks that the rejection be withdrawn for at least this reason.

Conclusion

The Applicant believes that it has responded to each ground of rejection raised by the Examiner, and that for at least the reasons cited above the claims, as presented, are in condition for immediate allowance. The Applicant respectfully requests reconsideration and allowance of the claims.

The Applicant is concerned to advance this application as quickly as is reasonably possible. Accordingly, the Applicant respectfully requests that, in the event the Examiner has any further questions about this application, the Examiner call the Applicant's attorney at the number provided below.

The Applicant believes that no further fees are due in connection with the filing of this paper. In the event that the office determines that any further fee is due, the Applicant requests that such fee be charged to its Deposit Account No. 195113.

The Applicant requests that any questions concerning this matter be directed to the undersigned.

Respectfully submitted,

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